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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,861	12/12/2001	Neil S. Cutshall	240083.514	2603

500 7590 02/26/2003  
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EXAMINER
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DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/015,861

Applicant(s)

CUTSHALL ET AL.

Examiner

RITA J. DESAI

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-44 is/are pending in the application.
- 4a) Of the above claim(s) 31-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 13-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### DETAILED ACTION

Claims pending 1,4-1113-16,18-30.

Applicants have not cancelled the method claims 31-44 .

The objection to claim 4 and 12 has been withdrawn since applicants have amended claim 4 and canceled claim 12.

The claims 16, 18-29 rejection under 35 USC 112 still stands since applicants arguments are not convincing. Applicants argue that the claim is read in light of the specifications.

Applicants definition of an aryl is a aromatic ring monocyclic or polycyclic ring.

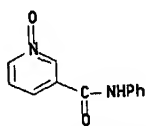
Applicants claim 1 just states it is an aryl or an aryl(alkylene). It does not say it can be optionally substituted.

Thus the claim itself does not have any antecedent basis for the substitution.

The rejection of claims 1,2 and 4 ( also included is claim 13) still under 35 USC 102 b over

Mirek Julian 1971 45 (2) pages 205-9 still stands.

The reference discloses



See RN # 14178-43-9.

It reads on the compounds when n is 0 R2 is hydrogen and R3 is a phenyl.

Applicants proviso clearly states when is 0 and R3 is phenyl optionally substituted by methoxy,

R1 cannot be selected from R5, when R5 is a hydrogen.

### *New Grounds of Rejection*

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**SCOPE OF ENABLEMENT**

Claim 1, 5, 6, 8, 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for R1 and R4 being aryl or alkyl, halogen, does not reasonably provide enablement for any heteroaryl, heterocycle aliphatic ring. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The various groups for R1 and R4 are not enabled and would require an undue amount of experimentation to make and use them.

In re Wands, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Ex Parte Forman, 230 USPQ 546 (Bd of App. 1986).

The presence of different groups which may be larger than the compound core itself would certainly have an effect on the various functional groups and oxide itself. This would require different solvents, protective groups, and steps to make and use them.

The breadth of the claims is too broad and the predictability in the art is very low, that one of average skill in the art would be able to make and use the compounds without any UNDUE experimentation.


The claims are still not allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A handwritten signature in cursive script, appearing to read "R. Desai", with a horizontal line drawn underneath it.

R.D.  
February 25, 2003